

Appl. No. 09/721,550
Amdt. dated March 12, 2004
Reply to Final Office action of December 15, 2003

Docket No. 58027-010300

REMARKS

Applicant has carefully considered the Final Office Action of December 15, 2003 and set forth detailed responses herein.

Many thanks to Examiner Foreman for her extensive and most informative discussions regarding the presently submitted new claims and references in the case. Previously pending Claims 1, 4-7, 10-18, 20, 23, 25, 29, 31, 34-35, 37-40 have been cancelled without prejudice or disclaimer for prosecution in possible continuation filings. New claims 41 to 71 are presented, in accordance with suggestions and discussions held with Examiner Foreman.

Applicant further notes and thanks the Examiner for acknowledging Applicant's claim for domestic priority, as cited in the Office Action of December 15, 2003.

The Examiner has objected to the amendment of filed on September 29, 2003 for reciting the phrase "herein incorporated by reference in its entirety". This phrase is herein cancelled by this amendment, as shown in the "AMENDMENTS TO THE SPECIFICATION" above. Thus the Examiner's objection has been overcome and Applicant respectfully requests the Examiner to withdraw this objection.

Previously pending Claim 6 has been cancelled, and thus the Examiner's objection is rendered moot. Accordingly, Applicant respectfully requests the Examiner to withdraw the objection.

The Examiner's rejections of Claims 1, 4, 7, 23, 25, 29, 31 and 38 under 35 U.S.C. § 102(e) as being anticipated by Wu et al. (U.S. Patent 5,846,729), as well as rejections of Claims 5, 6, 34, 35, 37 and 39 under 35 U.S.C. § 102(e) and (a) as anticipated by Wu et al. as defined by Egholm et al. (Nature, 7 October 1993, 365:566-568, are also rendered moot in light of at least the cancellation of these pending claims. Furthermore, nowhere in Wu et al. nor Egholm et al. can be found the method steps for quantifying an amount of a target molecule as presently claimed in independent New Claims 41, 49 and 59, such as, for example, the step of repeating steps e through h until quenching of said fluorescing nucleotide probes is reduced until all target molecules are hybridized and no longer quench the fluorescing nucleotide probes of

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claim 41 or repeating steps a. through g of claim 49, with subsequent substrates, having surface areas comprising known numbers of fluorescing nucleotide probes until all target molecules are hybridized and no longer quench the fluorescing nucleotide probes.

Applicant respectfully requests that the Examiner withdraw all 35 U.S.C. § 102 rejections.

Claims 10-13, 16, 17 and 20 are currently rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. in view of McGall et al. (U.S. Patent No. 6156501). Cancellation of all previously pending claims renders these rejection also moot. McGall et al has been the subject of much discussion during previously submitted responses to Office Actions, and the arguments presented previously regarding McGall et al. are herein incorporated by reference into this response. As discussed above, nowhere in McGall et al. can method steps be found that correlated with the currently claimed methods of newly submitted claims 41-71. McGall et al. fails to compliment the shortcomings of the disclosure of Wu et al. regarding the methods presently claimed. Therefore, withdrawal of all 35 U.S.C. § 103(a) rejections is respectfully requested.

Previously pending Claims 14 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. in view of Hornes et al. (U.S. Patent No. 5512439). As above, these rejections are now moot in light of the cancellation of these claims and newly submitted patentable claims 41-71. Hornes et al. and Wu et al. both, either alone or in combination, fail to teach quantitation methods as presently claimed. Accordingly, these rejections should be withdrawn.

Now cancelled Claim 18 is also rejected under 35 U.S.C. § 103(a) as unpatentable over Wu et al. in view of McGall et al. as above and in view of Vyas et al. (U.S. Patent No. 5776711). The use of flow cytometry in the pending claims is appended to the aforementioned patentable independent method Claim of 59, the steps of which may not be found in the cited references. In accordance with the cancellation and discussion above, this 35 U.S.C. § 103(a) rejection should also be withdrawn.

Likewise, the rejection under 35 U.S.C. § 103(a) as being unpatentable over Wu et al. as

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defined by Egholm et al. and in view of McGall et al., is now moot in light of the pending recitations of method steps in newly submitted Claims 41-71. This rejection should also be withdrawn by the Examiner.

In view of the foregoing, it is respectfully submitted that Claims 41-71 in the application are in condition for allowance. Allowance of the Claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicants' undersigned representatives, attention Claude Nassif, Ph.D. at (310) 586-7828 to discuss the steps necessary for placing the application in condition for allowance.

This response is timely filed and no fee is believed due. However, if the Applicant is mistaken, The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred to when charging any payments or credits for this case.

Respectfully submitted,

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